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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/999,308 12/29/97 FUJINO

N FUJ014691

WM02/0821

EXAMINER

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EMPIRE STATE BUILDING  
60TH FLOOR  
NEW YORK NY 10118-0110

ENG. G

ART UNIT

PAPER NUMBER

2643

DATE MAILED:

08/21/01

23

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
08/999,308

Applicant(s)

Fujino et al.

Examiner

George Eng

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Jun 11, 2001

2b)  This action is non-final.

2a)  This action is FINAL.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-6, 8-14, and 16-28

is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_

is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_

is/are allowed.

6)  Claim(s) 1-6, 8-14, and 16-28

is/are rejected.

7)  Claim(s) \_\_\_\_\_

is/are objected to.

8)  Claims \_\_\_\_\_

are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage

application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 6/11/2001 (paper no. 21) for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/999,308 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Response to Amendment***

2. This office action is in response to amendments filed 5/9/2001 and 6/12/2001 (papers no. 18 and 22).

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-6, 8-14 and 16-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 9, 16 and 22, the term "may" render the claims indefinite because the term "any" has an alternative meaning which cannot positively identify the claimed limitation, thereby it is unclear whether fetching data including information which is required by a user or not.

Claims 2-6, 8, 10-14, 17-21, 23-28 are also rejected because of depending on their respective independent claims containing the same deficiency.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-6, 8-14 and 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shachar et al. (US PAT. 5,764,736 hereinafter Shachar) in view of Van Hoff et al. (US PAT. 5,919,247 hereinafter Van Hoff).

Regarding claim 1, Shachar discloses a communication system as shown in figure 1 comprising a server (124) providing information, a terminal (100) communicating data with the server, and a communication network (122) connecting said server to said terminal (col. 7 line 38 through col. 8 line 26), wherein the system further comprises a temporary line disconnection unit for

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temporary disconnecting a line being used for primary data communication without issuing any disconnection notifications of the terminal when a third party other than the server is being voice communicated during a data communication between the terminal and the server (figure 4b and col. 14 lines 2-20), a data fetch unit for automatically fetching data from the server to the terminal (figure 4a and col. 13 lines 7-40), a storage unit for storing data fetch by said automatic data fetch unit (col. 13 lines 62-66), wherein a data communicating process is preformed from a status at a point immediately before starting the voice communication when said server and said terminal resume the data communication (figure 4c, col. 12 lines 34-57 and col. 14 lines 41-51). Note while Shachar teaches the communication system is able to download information from the server during data communication in the storage unit and to access the storage unit in order to accomplish various tasks (col. 8 lines 51-67, col. 10 lines 33-49 and col. 11 lines 35-41) so that the communication is capable of providing virtual data communication during voice communication. Shachar differs from the claimed invention in not specifically teaching that the data fetch unit fetching data of web sites including information which a user requires. However, Van Hoff teaches a system for distributing data to clients over a network comprising a client system using a tuner process for downloading and storing entire web site contents on a local hard disk upon a request is made so that a user can access the web site contents without further network traffic (col. 2 line 50 through col. 3 line 9 and col. 12 line 63 through col. 13 line 6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shachar in having the tuner process as taught

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by Van Hoff because it makes user friendly so that it makes possible to use an application from a particular web site even if client system is not connected to a network.

Regarding claim 2, Shachar teaches the terminal obtaining a telephone number of the third party as information during the data communications (col. 10 lines 54-60).

Regarding claims 3-5, Shachar teaches the server comprising a telephone switch unit and the temporary line disconnecting unit provided in the terminal and the server for disconnecting between the terminal and the server when the terminal issues a request for voice communication with the third party (col. 11 line 7 through col. 12 line 49).

Regarding claims 6 and 8, Shachar discloses at least one unit provided on a server side for each use who receives a service of said server for managing personal information and communications status of each user (col. 9 lines 4-17 and col. 12 lines 23-49).

Regarding claims 9,16 and 22, the limitations of the claims are rejected as the same reasons set forth in claim 1.

Regarding claim 10, 17 and 23, the limitations of the claims are rejected as the same reasons set forth in claim 2.

Regarding claims 11-13, 18-20 and 24-26, the limitations of the claims are rejected as the same reasons set forth in claims 3-5.

Regarding claim 14, 21 and 27-28, the limitations of the claims are rejected as the same reasons set forth in claims 6 and 8.

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***Response to Arguments***

6. Applicant's arguments with respect to claims 1-6 and 8-14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-6306, (for formal communications intended for entry)

**Or:**

(703) 308-6296 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

*George Eng*  
GEORGE ENG  
PATENT EXAMINER  
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August 17, 2001